

REMARKS

Claims 1-14, 17, 19-24, 33, and 34 were previously canceled. By this amendment, claims 15-16, 18, 26-28, 30-32, 35-36, 38, 40, and 45 have been amended. Claims 25 and 41-44 are canceled. New claims 46-56 are added. Accordingly, Claims 15, 16, 18, 26-32 and 35-40, 45-56 are now pending in the application. Reconsideration of the claims in view of the above amendments and the following remarks is earnestly requested. An early allowance is also requested considering the time this case has been pending before the USPTO.

In addition, the Applicant requests that the Examiner phone Applicant's attorney to discuss the case before picking up the case and further examining same.

Telephone Interview Summary

A telephone interview was conducted with the Examiner, Dov Popovici, and the Examiner's Supervisor, Mark Zimmerman, on January 28, 2011. In the interview it was agreed that the rejection under 35 U.S.C. 112, first paragraph, should be withdrawn as there was sufficient support in the written description for receiving medical data through a software module and parsing patient identification information and study information from the received medical data. Other art rejections were discussed but no agreement was reached.

There was a discussing for the basis of the term parsing. However, applicant disagrees that the Pelanek reference teaches parsing.

Claim Objection

On page 2 of the Office Action dated September 3, 2010, the Examiner objected to claim 38 because of the following informalities: In claim 38, line 2, after "times.", "39." should be deleted. The Examiner required correction.

By this amendment, the "39." after the end of the claim was deleted to overcome the Examiner's rejection.

35 U.S.C 112 Rejections

A. Examiner's Rejection

On page 2 of the Office Action dated September 3, 2010, the Examiner rejected claims 42-44 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Examiner, claims 42-44 depended from the wrong claim.

B. Response to Examiner's Rejection Under 35 U.S.C. 112, Second Paragraph

In this response, the Applicant has amended claims 42-44 to correct the dependency. Claims 42-44 now depend from claim 41. Accordingly, the Examiner's rejection under 35 U.S.C. 112, second paragraph is now moot.

C. Examiner's Rejection

On page 3 of the Office Action dated September 3, 2010, the Examiner rejected claims 15-16, 18, 25-32 and 35-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the claims 42-44 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

D. Response to Examiner's Rejection Under 35 U.S.C. 112, First Paragraph

On January 28, 2011, in a telephone interview with Applicant's Attorney, Examiner, Dov Popovici, and Supervisory Examiner, Mark Zimmerman, it was agreed to withdraw the rejection under 35 USC 112, first paragraph. As a result, the rejection of claims Claims 15-16, 18, 25-32 and 35-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement has been withdrawn and no longer exists thereby dispensing with the need to respond to this rejection.

35 U.S.C. 102 Rejection

Rejection under 35 USC 102(e)

Claims 15-16, 18, 25-26, 29-32 and 35-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright et al. (US Patent No. 7,302,164, "Wright et al." hereafter).

Response to Rejection under 35 USC 102(e)

In the previous office action, applicant elected to swear behind the reference. In this response, the applicant has elected to argue the reference. Even though Applicant has elected to argue the reference, Applicant reserves the right to swear behind the Wright et al. reference at a future date.

The Wright et al. reference claims priority to a provisional patent application which was filed on February 11, 2000. The provisional patent application had a limited amount of disclosure. In fact, the Wright et al. case was the subject of a reexamination proceeding in which the priority date of the application was determined to be the filing date of the nonprovisional application (January 17, 2001) rather than the filing date of the provisional patent application (May 19, 2000) to which the regular application claimed priority. The Examiner's analysis from the reexamination proceeding at the US Patent and Trademark Office is repeated below for the convenience of the reader:

Pursuant to MPEP 2258 cited above, the examiner may evaluate the support provided for foreign or U.S. patent applications as part of the reexamination proceeding, in order to determine the effective filing date of the patent and determine the existence of intervening prior art relative to the filing date. In initiating this analysis, the requester has asserted a lack of support provided by the U.S. provisional application 60/181,985 such as to prevent the priority claim under 35 USC 119(e) in US Patent 7,302,164.

In particular, 35 USC 119(e)(1) recites:

"An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111 (a) or section 363 of this title is filed not later than 12 months

after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. "

As seen from the first lines of this statute, a provisional patent application must be "disclosed in the manner provided by the first paragraph of section 112 of this title." 35 USC 112, first paragraph, recites:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. "

The provisional application 60/181,985 as filed is described by the requester at page 8, second to last paragraph through page 9 fourth paragraph of the request. The contents of the provisional application have been reviewed, along with requester's remarks regarding the contents of the provisional application. This review finds that provisional application 60/181,985 contains none of the drawings ultimately deployed in US patent 7,302,164, and as best as can be determined, no common description. The provisional application 60/181,985 appear to be a series of high level descriptions of the overall functionality of system, such as would typically be found in marketing brochures. None of the elements set forth in FIGS 1-5 of US patent 7,302,164 can be correlated with any reasonable certainty to the materials set forth in the provisional patent application and no figures exist in common. Notwithstanding the degree of correlation between the provisional application and the patent in question, these brochures, taken by themselves, do not provide *"the manner and process of making and using it, in such full, clear and concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same"*. A person of ordinary skill in the art would not be able to construct or produce the claimed invention in the patent by using the complete content of the provisional application, which is essentially composed of marketing information, expression of cost savings and descriptions of functional benefits of the overall system. Accordingly, examiner finds that the provisional application 60/181,985 does not provide the requisite degree of support required to meet the provisions of 35 USC 112, first paragraph, and thus does not meet the requirements of 35 USC 119(e) incorporating these requirements.

The effective priority date found for U.S. Patent 7,302,164 is thus the U.S. filing date for the non-provisional application, which is January 17, 2001." (See pages 3 and 4 of Office Action dated January 30, 2009 of Reexamination No. 90/009,347)

Based on the above, Applicant submits that since the effective date of the Wright et al. reference has been determined to be the nonregular application date of January 17, 2001, the

Wright et al. reference is an improper 102(e) reference since the effective filing date of the Wright et al. reference (January 17, 2001) is after the effective filing date of the instant reference (May 19, 2000).

Even if the Wright et al. reference is somehow considered a proper 102(e) reference, the material that could be relied on for any type of art rejection is limited to the disclosure found in the provisional application. According to MPEP 2136.03, subsection III entitled "PRIORITY FROM PROVISIONAL APPLICATION UNDER 35 U.S.C. 119(e)"

"The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph." (MPEP 2136.03, subsection III, emphasis added with underlining).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation for the reasons set forth in the following paragraphs.

Claim 15, as amended, now recites:

- creating a job containing medical data for a patient, and medical data image viewing software, and
- providing print information for autoloader control software, the print-information having selected fields obtained from an automatic scan of the stored parsed patient identification information,
- submitting the job to the autoloader control software, and
- recording DICOM image information from the one or more files on the recording media,
- recording other files as defined by DICOM on the recording media,

automatically printing selected fields of the automatically scanned and stored parsed patient identification information on the recording media to label the recording media.

The Wright et al. reference fails to teach each and every claim element of claim 15. For example, the Wright et al. reference fails to teach automatically printing selected fields of the automatically scanned and stored parsed patient identification information on the recording media to label the recording media, as recited in claim 15. The provisional filing of Wright et al. fails to teach automatic printing. The term automatic is in the Wright et al. provisional but only with respect to presenting a physician with a systems default web browser upon insertion of a CD into a "standard CR-ROM drive" (see 2nd paragraph of the CopyDat Functional Operation section of the Provisional Application). This is not automatically printing as recited in the claim.

The section of the Provisional Application that discusses printing is in the first paragraph of the CopyDat Functional Operation section of the Provisional Application. In that section, it describes the computer used as "...a single 500 MHz Pentium based PC with 128 MB of RAM and a 18 GIG hard drive and a SCSI based CD-RW device..." This is a standard computer with a CD-RW bay that can be used to burn CDs. There is no printer for the CD mentioned with respect to the system. The specification dubs this as a DatCard PC which is set up as a DICOM SCP according to the DICOM protocol, thereby allowing the device to receive DICOM files and store them onto the 18 GIG hard drive of the standard computer as described without human intervention.

The Wright et al. process then requires human intervention. According to the Wright provisional, "...any user with the proper security can walk up to the DatCard PC type in the patients name and/or identification number, review the images and write them to the DatCard CD. The system will also simultaneously print a label containing the patient's demographics that will then be attached to the CD." (see 2nd paragraph of the CopyDat Functional Operation section of the Provisional Application). This appears to be the only point in the provisional application where a printer is even mentioned. There is no printer shown in the figures of the provisional application. Given that a standard PC is described without showing any type of printer, it stands to reason that a standard, stand alone printer is all that could be "taught". In this case, the label would be printed at the standard, stand-alone printer and would be applied

by a human to the CD after recording and human removal by the user. This is not automatic and is prone to error introduced by human intervention. All that has to happen is that one recorded CD be laid aside. After that, every CD that follows would be mislabeled since the wrong label would be applied due to human error.

In addition to this there is no teaching, much less enabling disclosure, as to how the contents for the label are provided. In fact, there is no teaching of creating a job or providing print information for the label, much less "...creating a job containing medical data for a patient, and medical data image viewing software, and providing print information for autoloader control software, the print-information having selected fields obtained from an automatic scan of the stored parsed patient identification information..." as recited in Claim 15.

As a result, the Wright et al. reference is not a proper 102(e) reference, or in the alternative fails to anticipate all the elements of claim 15 as now amended. As a result, the rejection of claim 15 under 35 U.S.C. 102(e) as being anticipated by Wright et al. is overcome.

It should be noted that support for automatic printing can be found in several places in the instant application. For example, the first line of paragraph [0008] discusses automatically scanning and printing selected fields of information on the discs for ease of file management. This is consistent with one of the objects of the invention which is to "...reduce clerical time and reduce errors by having discs printed with information from files stored on the discs." (See paragraph [00012] of the patent application as published 2002/0085476). Further support can be found in other objects of the invention as well as the discussion of the software for forming the job which also executes "the printing software to print the label containing the input fields on the CDR." (see paragraphs [0058] to [0060], the quoted portion is at the end of paragraph [0060]).

Claims 16, 18, 25-26, 29-32, and 45 depend, either directly or indirectly, from independent claim 15. By their dependency, claims 16, 18, 25-26, 29-32 and 45 all include the limitations of the independent claim. Accordingly, claims 16, 18, 25-26, 29-32 and 45 also now overcome the Examiner's rejection under 35 U.S.C. 102(e) as being anticipated by Wright et al.

Claim 35 recites the following:

automatically scanning the medical data information for selected fields from one or more files,

noting the end of the received medical data information through the software module for each patient,
creating a job for a patient containing medical data, and medical data image viewing software, and
providing a print information file for an autoloader control software, the print information file having selected fields obtained from an automatic scan of the stored parsed patient identification information and the stored parsed study information,
submitting the job to the autoloader control software, and
recording at least one DICOM image on a disc,
recording other files as defined by DICOM on the disc, and
automatically printing selected fields of the stored extracted patient identification information and the stored extracted study information, the selected fields used to label the disc.

With respect to claim 35, the Wright et al. reference is not a proper 102(e) reference, or in the alternative, fails to anticipate all the elements of claim 35 as now amended. The reasons for Wright et al. not being a proper 102(e) reference are set forth in the argument above with respect to claim 15.

The Wright et al. reference also fails to teach automatically scanning medical data for selected files, noting the end of the received medical information, creating a job that includes the selected files, and automatically printing selected fields to label the disc. Simply put, claim 35 overcomes the Examiner's rejection under 35 U.S.C. 102(e) as being anticipated by Wright et al. since Wright et al. is either an improper 102(e) reference or fails to teach all the elements of claim 35.

Claims 36-40 depend, either directly or indirectly, from independent claim 35. By their dependency, claims 36-40 all include the limitations of the independent claim. Accordingly, claims 36-40 also now overcome the Examiner's rejection under 35 U.S.C. 102(e) as being anticipated by Wright et al.

Claims 41-44 have been canceled by this amendment, thereby obviating the Examiner's rejection under 35 U.S.C. 102(e) as being anticipated by Wright et al. with respect to those claims.

35 U.S.C. 103 Rejection

A. Rejection of Claims 27-28 under 35 U.S.C. 103(a)

Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. in view of Farrell et al. (US Patent No. 5,717,841, "Farrell et al." hereafter). In the office action, the Examiner relied on the teachings of Wright et al. for most of the elements of these claims. The Examiner relies on Farrell et al. for its disclosure of "...a printing system and improving system performance, efficiency and speed by reducing the number of inactive jobs stored in the system memory." According to the Examiner, the "...number of inactive jobs can be reduced by causing automatic job archiving and deletion upon the occurrence of a predetermined triggering event (see column 2, lines 33-38)."

B. Response to Rejection of Claims 27-28

The USPTO found that the Wright et al. reference date was after the filing date of the instant reference. Therefore, the Wright et al. reference is not prior art and not combinable with Farrell et al. As a result, the rejection is improper.

In the alternative, if the Wright et al. reference is somehow found to be a proper reference, the rejection under 35 U.S.C. 103(a) as being unpatentable over Wright et al. in view of Farrell et al. is overcome since the Examiner has failed to make out a proper *prima facie* case of obviousness with respect to the claim as now amended.

In order for the Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claims 27 and 28 depend, indirectly, from Claim 15 so include all the elements of that claim and any intervening claim. As argued above, the Wright et al. reference fails to include several of the elements of claim 15. The Farrell et al. reference also fails to teach these elements. Accordingly, the prior art references fail to teach all the claim limitations of claims 27 and 28. In addition, there does not appear to be any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to even combine reference teachings. The invention of claim 15 is directed toward a method of producing recordable media with DICOM files thereon and having a label automatically printed on the recording media so as to reduce clerical time and reduce errors (see paragraph [0012] and claims 15, 27 and 28). The Farrell et al reference is directed to a reprographic system that allows "...an operator of an electronic reprographic system to be able to select deferred actions for inactive print jobs which are automatically initiated upon the detection of a specified triggering event." (see Abstract of the Farrell et al. reference). There is no reason to look to Farrell et al. when developing the invention as claimed since it requires an operator's intervention. Accordingly, the Examiner's rejection also fails to make a proper prima facie case since there is no suggestion or motivation to combine these references. Therefore, the rejection of claims 27 and 28 under 35 U.S.C. 103(a) as being unpatentable over Wright et al. in view of Farrell et al. is overcome.

C. Rejection of Claims 15-16, 18, 26, 29-32 and 35-45 under 35 U.S.C. 103(a)

Claims 15-16, 18, 26, 29-32 and 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Kahle (U.S. Patent No. 5,518,325) and further in view of Murray et al. (U.S. Patent No. 5,721,891), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Kahle (U.S. Patent No. 5,518,325) and further in view of Murray et al. (U.S. Patent No. 5,721,891), and further in view of Wright et al. (U.S. 7,302,164 B2), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Wright et al. (U.S. 7,302,164 B2), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Wright et al. (U.S. 7,302,164 B2).

D. Response to Rejection of Claims 15-16, 18, 26, 29-32 and 35-45

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

The Examiner fails to make a proper *prima facie* case of obviousness for several reasons including that there is no suggestion or motivation to combine references. The invention of claim 15 deals with storing and recording one or more files on a recordable media. This aspect of the invention is recited. Claim 15 recites "...storing DICOM image information coming from the one or more files..." The Pelanek reference, in contrast, deals with a totally different problem of storing a single file when the file exceeds the capacity for a single type of media. The summary of the Pelanek reference states:

"Where the medical image data exceeds the capacity of a single disk, the entire set of medical images is recorded as lossy compressed medical images on each disk of the plurality of disks which record the set of medical images as substantially losslessly compressed medical images." (See Column2, line 64 to Column 3, line 2 of the Pelanek reference)

One of ordinary skill in solving the problem of storing one or more files to a recording media would not look to the Pelanek reference as it teaches a solution opposite the claimed invention. Each of the various combinations of references includes the Pelanek reference. As shown above, there is no suggestion or motivation to combine Pelanek with any of the other references to yield the invention as claimed.

In addition, the various combinations of references also fail to teach each and every element of the invention as claimed. Claim 15 also recites the element of "...receiving medical data information in DICOM format according to the DICOM protocol through a

software module and parsing patient identification information and study information from the received medical data information, the medical data further comprising one or more files,"...and..."noting the end of the received medical data information through the software module for each patient". The Pelanek reference does not deal with DICOM files but rather oversized lossy files so the receiving step is not met. In addition, there is no need for noting the end of the received medical data since one file relates to one patient. There is no need for noting the end of the receipt of one or more files or the end of medical data received for a patient.

Kahle fails to teach receiving a DICOM file. Kahle also has not need to note the end of the received medical data information through a software module for each patient since it receives the data and prints it. Kahle basically handles one file at a time. Kahle handles one data stream at a time so there is no need to note the end of receipt of a particular patients files.

Kahle is directed toward an optical recording device that includes an ink jet type printer for writing a title to the disk as the disk is in and as it leaves the position where it was recorded. Kahle indicates that the

"...recording device will have a recording chamber and a carriage for delivering and ejecting the compact disk to and from the recording chamber. **The carriage is slidable in an axial direction to deliver and eject the disk to or from the recording chamber. The printer also has a print head slidably mounted on the recording device over the path of the carriage.** The print head is slidable in a direction that is perpendicular to the axial travel of the carriage. **In this manner, the visual label can be printed anywhere on the surface of the disk as the disk is either delivered to or ejected from the recording device.**" (See column 3, lines 3-13 of the Kahle reference)

The first embodiment of Kahle's combination recorder and printer is a device that includes a controller that extracts title information from the data stream it sends to the recorder portion of the combination recorder and printer.

"The transfer of digital information from the storage location 26 is controlled by the controller 28, where a digital data stream is created which is fed to the CD recorder 24. Interfaces between the storage location 26 and the controller 28 as well as between the controller 28 and the CD recorder 24 for transferring the data stream are well known in the art, e.g. SCSI. In many cases, the storage location 26 will be part of the computer system which defines the controller 28. That is, the present invention will frequently be used for downloading information from an integrated computer system onto the CD-R 10. "

"In a first embodiment, a portion of the digital data stream that is transferred to the CD recorder 24 can be extracted by the controller 28 and delivered to a printer 30. The portion of the data stream that is extracted by the controller 28 contains **title information** as previously described. The title information is sent to the printer 30 to print a visual label on the CD-R 10. To extract the portion of the digital data stream having the title information, the controller 28 uses software available from vendors such as Bell & Howell, Chicago, Ill." (Column 5, lines 47-66 of the Kahle reference)

Kahle defines the "title information" in the specification:

"By a visual label is meant that title information on the label is human readable (the preferred embodiment) or machine readable (such as when the label is in the form of a bar code). The title information will uniquely identify the information recorded on the CD-R. **The title information can include, but is not limited to, the name of the particular database file being recorded on the CD-R, a brief description of the type of information recorded on the CD-R, a table of contents, or the like.** Further, the title information can contain information relating to distribution, mailing, filing, retrieval, security, controlled copy number, etc." (Column 4, lines 8-16 of the Kahle reference, bolding added for emphasis)

The title information, according to the specification, comes from the name of the database file. There is no teaching that the extracted information comes from within any file or any portion of any file. As a result, Kahle fails to teach or suggest that "...the stored parsed study information and patient information coming from the one or more files..." as now recited in claim 15. Pelanek is of no help here since it deals with the storage of one large file over a number of media. Thus, the combination of Kahle and Pelanek still falls short since the combination fails to teach each and every element of the claimed combination.

The Murray reference seems to be cited by the Examiner for a timer that is used to detect a bit serial communication stream of N length. There is no need to employ Murray in either Kahle or Palenak since each handles one file at a time. Therefore, adding the timer of Murray to either Kahle or Palenak would merely be adding an unneeded feature. Since neither Kahle or Palenak handle "unformatted unlimited-length serial bit streams" (Field of the Invention of Murray et al.) associated with a "communications protocol" (Field of the Invention of Murray et al.) there is no teaching or suggestion to combine these various teachings. If one were to combine these references as suggested by the Examiner, one would come up with an internal integrated media recording device that would deal with recording single files that are

larger than the capacity of a single disk or other single unit of media, and label them with file names plucked from a file directory while the CD is moved to the printing location located near the CD writing or burning location. Murray would destroy the combination of Kahle and Palenak since it would require unformatted serial bit streams, and even if it was appropriate to combine all the references the resulting device would have a superfluous, unneeded timer.

In addition, there is no mention of patient information or study information or parsing a file's patient information or study information in any of the Pelanek, Kahle, or Murray references.

Furthermore, there is no mention in any of the Pelanek, Kahle, or Murray et al. references teaching or suggesting the printing of selected fields from parsed information to label the disc where the parsed information is patient identification information parsed from received medical data. This is recited in the last element of claim 15.

As a result of the above arguments, it is respectfully submitted that the Examiner has failed to make out a proper prima facie case of obviousness. Accordingly, the rejection under 35 U.S.C. 103(a) as being unpatentable over Pelanek et al. (US Patent No. 5,724,582) in view of Kahle (US Patent No. 5,518,325) and further in view of Murray et al. (US Patent No. 5,721,891) is overcome.

In addition, claims 16, 18, 26 and 29-32 depend, either directly or indirectly from claim 15 and include the limitations of claim 15 by their dependence. Accordingly, claims 16, 18, 26 and 29-32 also overcome the rejection under 35 U.S.C. 103(a) as being unpatentable over Pelanek et al. (US Patent No. 5,724,582) in view of Kahle (US Patent No. 5,518,325) and further in view of Murray et al. (US Patent No. 5,721,891).

Claim 35 includes many of the same elements as claim 15. Claim 35 recites:

receiving medical data information in DICOM format through a software module communicatively coupled to a network, and
extracting patient identification information and extracting study information from the received medical data information,
storing DICOM image information coming from the medical data information,
storing the extracted patient identification information and extracted study information, from the medical data information
automatically scanning the medical data information for selected fields from one or more files,

noting the end of the received medical data information through the software module for each patient,
creating a job for a patient containing medical data, and medical data image viewing software, and
providing a print information file for an autoloader control software, the print information file having selected fields obtained from an automatic scan of the stored parsed patient identification information and the stored parsed study information,
submitting the job to the autoloader control software, and
recording at least one DICOM image on a disc,
recording other files as defined by DICOM on the disc, and
automatically printing selected fields of the stored extracted patient identification information and the stored extracted study information, the selected fields used to label the disc."

As argued above, there is no teaching or suggestion to combine the Palenек et al. reference with any other reference since it is directed to the totally opposite problem of splitting a large lossy file for recording onto two discs. In addition, none of Palenек et al., Kahle, and Murray handle DICOM files so there is no teaching of "... receiving medical data information in DICOM format through a software module communicatively coupled to a network, and...storing DICOM image information coming from the medical data information..." There is no element for noting the end of the received medical data for each patient since both Palenек et al. and Kahle each handle single files. Murray's timer would be a useless add on to either Palenек et al. or Kahle. Furthermore, there is no recitation of handling more than one file in the teachings of the references. Furthermore, there is no indication of automatically scanning the medical information for selected fields and then printing a label based on the selected fields scanned. Kahle takes the print command it is given. Palenек et al. has no need for this and does not teach labeling. As a result, claim 35 overcomes the rejection based on the combination of Palenек et al. in view of Kahle. Claims 36-40 depend from claim 35 and include the recitation of claim 35 by their dependency. As a result claims 36-40 also overcome the rejection based on the combination of Palenек et al. in view of Kahle and in further view of Murray

Claims 41-45 have been canceled and therefore obviate the rejection.

The Examiner also rejected the claims by adding the Wright et al. reference to the combinations already discussed above. It should be noted that the Wright et al. reference is not proper prior art since the USPTO made the following determination:

The effective priority date found for U.S. Patent 7,302,164 is thus the U.S. filing date for the non-provisional application, which is January 17, 2001." (See pages 3 and 4 of Office Action dated January 30, 2009 of Reexamination No. 90/009,347)

Since the effective filing date is after the filing date of the provisional filed in the instant case, the Wright et al. reference should not have been used as a basis for the 103(a) rejection. If somehow, the USPTO determines that Wright et al. is a proper reference, the Examiner is not entitled to use the entire patent as art, but is rather limited to the disclosure found in the provisional application (No. 60/181,985) to which Wright claimed priority since that is the only part of the reference that predated the applicants effective priority date. Each of the Examiner's rejections is based on nonprovisional portion of the patent. Applicant requests that the Examiner recast any arguments based on the material found in the provisional.

It should be noted that the Wright et al. provisional is of questionable enablement. The enablement was questioned by the USPTO in the reexam proceeding and the provisional document is clearly a proposal, as indicated by the developmental milestones set forth in the last pages of the provisional application.

E. Rejection of Claims 27-28 under 35 U.S.C. 103(a)

Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Kahle (U.S. Patent No. 5,518,325) and further in view of Murray et al. (U.S. Patent No. 5,721,891), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Kahle (U.S. Patent No. 5,518,325) and further in view of Murray et al. (U.S. Patent No. 5,721,891), and further in view of Wright et al. (U.S. 7,302,164 B2), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Murray et al. (U.S. Patent No. 5,721,891), and further in view of Wright et al. (U.S. 7,302,164 B2), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Wright

et al. (U.S. 7,302,164 B2), as applied to claims 15 and 26 above, and further in view of Farrell et al. (U.S. Patent No. 5,717,841).

F. Response to Rejection of Claims 27-28

Claims 27 and 28 depend from claim 15 and include the recitation of claim 15 by their dependency. As a result claims 27 and 28 overcome the rejection set forth above for the same reasons as set forth above in "C. Response to Rejection..."

G. Rejection of Claim 25 under 35 U.S.C. 103(a)

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Kahle (U.S. Patent No. 5,518,325) and further in view of Murray et al. (U.S. Patent No. 5,721,891), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Kahle (U.S. Patent No. 5,518,325) and further in view of Murray et al. (U.S. Patent No. 5,721,891), and further in view of Wright et al. (U.S. 7,302,164 B2), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Murray et al. (U.S. Patent No. 5,721,891), and further in view of Wright et al. (U.S. 7,302,164 B2), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pelanek et al. (U.S. Patent No. 5,724,582) in view of Wright et al. (U.S. 7,302,164 B2), as applied to claim 15 above, and further in view of Koritzinsky et al. (U.S. Patent No. 6,988,074).

H. Response to Rejection of Claims 25

Claim 25 also depends from claim 15. The teachings of Koritzinsky fail to cure the shortcomings of Pelanek, Kahle, and Murray et al. discussed above with respect to claim 15 and therefore claim 25 also overcomes the Examiner's rejection under 35 U.S.C. 103(a) of claim 25.

As a result of all the arguments set forth above, it is respectfully submitted that the Examiner has failed to make out a proper prima facie case of obviousness and that claims 15-16, 18, 26 and 29-32 now overcome the Examiner's rejection under 35 U.S.C. 103(a).

I should also be mentioned that Applicant incorporates all previous arguments made in previous responses by reference.

Miscellaneous

By this amendment, new claims 46 - 56 have been added. It will be appreciated by the Examiner that there is support for each element in these new claims. Support can be found in the summary of the invention section, specifically paragraph [0008], in the objects of the invention section, specifically in paragraphs [0011]-[0013] and [0016], and in paragraphs [0058] - [0060], as well as at other areas of the patent application as originally filed.

CONCLUSION

In view of these remarks, Applicants' claim is believed to be in condition for allowance. Upon entry of the above-response, Applicants respectfully requests reconsideration of the case and an early issuance of a Notice of Allowance. Applicant also requests that the Examiner call the attorney to discuss the case before substantively examining the case. If any additional fees are due in connection with the filing of this paper, please also charge these fees to Deposit Account No. 50-3141.

Respectfully submitted,

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